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JERRY.SHORMA@HP.COM

ipa.mail@hp.com

laura.m.clark@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN F. MEYER and STEVEN Y. KIM

Appeal 2008-005445
Application 09/785,969
Technology Center 3700

Decided: November 16, 2009

Before JENNIFER D. BAHR, JOHN C. KERINS, and MICHAEL W.
O'NEIL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

John F. Meyer et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-4, 7-27, 29-34, and 36. Appellants canceled claims 5, 6, 28, 35, and 37. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

The Invention

The claimed invention is to increasing the photo-taking capability of digital cameras without the need to purchase or carry additional memory or a laptop computer. Spec. 2, para. [0009]. The claimed invention, in essence, receives a digital image from the memory of an imaging device, e.g., a digital camera, and performs a point-of-sale transaction for storing the digital image at the remote site. Spec. 2, para. [0010].

Claims 1, 19, and 24, reproduced below, are illustrative of the subject matter on appeal.

1. A method comprising:
 - transferring at least one digital image from a memory associated with a customer's digital camera imaging device to a memory at a remote site;
 - displaying a price for storing the at least one digital image at the remote site;
 - prompting a customer for payment of the price;
 - receiving a payment for storing the at least one digital image at the remote site;
 - storing the at least one digital image at the remote site; and
 - printing a sales receipt including the price paid for storing the at least one digital image at the remote site, the date the payment was received and a thumbnail of the at least one digital image stored at the remote site.
19. A mini-kiosk comprising:
 - a memory card reader; and
 - a processor responsive to the card reader and programmed to perform a point-of-sale financial transaction for sending digital images from a user's digital camera to a remote storage site, the

processor confirming storage of digital images at the remote storage site in response to confirmation sent from the remote storage site, wherein the mini-kiosk is adapted for use by a plurality of customers.

24. An article for a transaction machine, the transaction machine adapted for use by a plurality of customers, the transaction machine having a processor and an interface, the article comprising:
computer memory linked to the processor, the interface communicatively coupled to the computer memory and the interface adapted to receive digital images from the plurality of customers; and
a program encoded in the computer memory, the program, when executed, instructing the processor to receive digital images via the interface, determine a price for storing the digital images at a remote site, process payment information, send paid-for digital images to the remote site, and to receive confirmation of storage of the paid-for digital images from the remote site.

*The Prior Art*¹

The Examiner relies upon the following as evidence of unpatentability:

| | | |
|----------|-----------------|---------------|
| Miyamoto | US 6,456,391 B1 | Sep. 24, 2002 |
| Safai | US 6,715,003 B1 | Mar. 30, 2004 |
| Parulski | US 6,836,617 B1 | Dec. 28, 2004 |

www.telepix.com.

¹ Documentation evidencing the existence of www.telepix.com and the Eastman Kodak press release is not present in the electronic file wrapper as of the date of this decision. Our decision today does not rest on this evidence.

Eastman Kodak: Kodak to acquire 51% state [*sic*] in Picture Vision, M2 Presswire, February 13, 1998, pg. 1.

The Rejections

The following Examiner's rejections are before us for review:

Claims 1-3, 7-10, 13-16, 18, 24-27, 33, 34, and 36 are rejected under 35 U.S.C. § 103(a) as unpatentable over Parulski in view of Safai and further in view of Miyamoto.

Claims 4, 17, 22, and 23 are rejected under 35 U.S.C. § 103(a) as unpatentable over Parulski in view of Safai and further in view of www.telepix.com.²

Claim 12 is rejected under 35 U.S.C. § 103(a) as unpatentable over Parulski in view of Safai further in view of Miyamoto "as applied to claims 1 and 11 above, and further further [*sic*] in view of Eastman Koda [*sic*]: Kodak to acquire 51% state [*sic*] in Picture Vision, M2 Presswire, February 13, 1998, pg. 1." Ans. 9.

SUMMARY OF DECISION

We REVERSE.

OPINION

All of Appellants' contentions focus on the prior art references of record failing to teach or suggest all of the claim limitations, such that the

² We assume because claims 4, 17, 22, and 23 depend from claims 1, 15, 19, respectively and the rejection of these claims includes Miyamoto in the § 103(a) ground of rejection, that Miyamoto should be included in this § 103(a) ground of rejection and its omission is a typographical error on the Examiner's part.

Examiner fails to establish a prima facie case of obviousness. In particular, Appellants contend Safai fails to describe the limitations the Examiner purports to be found within Safai at the particular citations. For instance, the step of or means for receiving payment for storing at least one digital image at a remote site, with respect to claims 1, 13, and 15; a processor confirming the storage of digital images at a remote storage site in response to confirmation sent from the remote storage site, as called for in claim 19; and a program encoded in a computer memory that instructs a processor linked to the computer memory to process payment information, as called for in claim 24.

The Examiner relies upon Safai's disclosure as the basis for finding the claim limitations of the step of or means for receiving payment for storing at least one digital image at a remote site (claims 1, 13, and 15), a processor confirming the storage of digital images at a remote storage site in response to confirmation sent from the remote storage site (claim 19), and a program encoded in a computer memory that instructs a processor linked to the computer memory to process payment information as being within the scope and content of the prior art. Ans. 3. The Examiner does not cogently explain how Safai's disclosure of a user initiating the "Develop option" described in col. 25, lines 43-50, or the display of the price for preparation and sending the desired photographic prints and the system determining that the price is acceptable to the user when the user selects the "NEXT option 415c" described in col. 27, lines 30-43, discloses or renders obvious the limitations stated above. The Examiner's statements in the grounds of rejection are conclusory and with respect to independent claims 19 and 24, the Examiner's reasoning is not specifically directed to the actual limitations

set forth in those claims. *See* Ans. 4. Further, upon review of the sections of Safai referenced by the Examiner, we cannot locate any description of the claimed limitations stated above. Therefore, Appellants have demonstrated error in the Examiner's findings regarding the scope and content of the prior art that led to the Examiner concluding that the prior art of record rendered obvious the claimed subject matter. The Examiner does not rely on Parulski, Miyamoto, telepix, or Kodak to cure this deficiency in the findings with respect to the scope and content of Safai. Accordingly, we do not sustain the Examiner's rejections of the claims.

DECISION

The Examiner's decision to finally reject claims 1-4, 7-27, 29-34, and 36 is reversed.

REVERSED

Klh

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
3404 E. Harmony Road
Mail Stop 35
FORT COLLINS, CO 80528